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10/761,551	01/21/2004	Aston G. Farquharson	END920030162US1	2855

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HOFFMAN WARNICK & D'ALESSANDRO, LLC
75 STATE STREET
14TH FLOOR
ALBANY, NY 12207

EXAMINER

TRAN, ELLEN C

ART UNIT	PAPER NUMBER
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2134

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/761,551

Applicant(s)

FARQUHARSON ET AL.

Examiner

Ellen C. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date Jan'04 & Feb'04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. This action is responsive to: an original application filed on 21 January 2004.
2. Claims 1-34 are pending; claims 1, 17, and 26, are independent claims.
3. The IDS submitted 21 January 2004 and 13 February 2004 has been considered.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-11, 14-17, 20-26, and 29-34**, are rejected under 35 U.S.C. 102(e) as being anticipated by Tackman et al. U.S. Patent No. 7,051,364 (hereinafter '364).

As to independent claim 1, A method for electronically executing contracts within a secure computer infrastructure, comprising: obtaining contract information from a receiving contract partner" is taught in '364 col. 7, lines 43-48;

"creating a contract within the secure computer infrastructure based on the contract information" is shown in '364 col. 7, lines 50-56;

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“requesting approval of the contract within the secure computer infrastructure from an originating contract partner and the receiving contract partner” is disclosed in ‘364 col. 6, lines 7-19;

“requesting execution of the contract within the secure computer infrastructure from the receiving contract partner and the originating contract partner after the contract is approved by the originating contract partner and the receiving contract partner” is taught in ‘364 col. 6, lines 53-65;

“and generating a final image of the contract within the secure computer infrastructure after the contract is executed by the receiving contract partner and the originating contract partner” is shown in ‘364 col. 11, lines 2-54.

As to dependent claim 2, **“where the step of requesting approval of the contract from the originating contract partner comprises communicating an electronic approval notification to the originating contract partner, wherein the electronic approval notification contains a link to the secure computer infrastructure”** is disclosed in ‘364 col. 6, lines 7-19.

As to dependent claim 3, **“further comprising: receiving login information from the originating contract partner; authenticating the login information; providing the originating contract partner with access to the contract within the secure computer infrastructure if the login information is authenticated; and receiving an approval determination from the originating partner”** is taught in ‘364 col. 6, line 66 through col. 7, line 13.

As to dependent claim 4, “where the step of requesting approval of the contract from the receiving contract partner comprises communicating an electronic approval notification to the receiving contract partner after approval by the originating contract partner, wherein the electronic approval notification contains a link to the secure computer infrastructure” is shown in ‘364 col. 9, line 56 through col. 10, line 5.

As to dependent claim 5, “further comprising: receiving login information from the receiving contract partner; authenticating the login information; providing the receiving contract partner with access to the contract within the secure computer infrastructure if the login information is authenticated; and receiving an approval determination from the receiving partner” is taught in ‘364 col. 6, line 66 through col. 7, line 13.

As to dependent claim 6, “where the step of requesting execution of the contract from the originating contract partner comprises communicating an electronic execution notification to the originating contract partner, wherein the electronic execution notification contains a link to the secure computer infrastructure” is shown in ‘364 col. 9, line 56 through col. 10, line 5.

As to dependent claim 7, “further comprising: receiving login information from the originating contract partner; authenticating the login information; providing the originating contract partner with access to the contract within the secure computer infrastructure if the login information is authenticated; and receiving an execution determination from the originating partner” is taught in ‘364 col. 6, line 66 through col. 7, line 13.

As to dependent claim 8, “where the step of requesting execution of the contract from the receiving contract partner comprises communicating an electronic execution notification to the receiving contract partner, wherein the electronic execution notification contains a link to the secure computer infrastructure” is shown in ‘364 col. 9, line 56 through col. 10, line 5.

As to dependent claim 9, “further comprising: receiving login information from the receiving contract partner; authenticating the login information; providing the receiving contract partner with access to the contract within the secure computer infrastructure if the login information is authenticated; and receiving an execution determination from the receiving partner” is taught in ‘364 col. 6, line 66 through col. 7, line 13.

As to dependent claim 10, “further comprising tracking all actions taken by the originating contract partner and the receiving contract partner in a database according to time, date and an IP address” is shown in ‘364 col. 11, lines 31- .

As to dependent claim 11, “wherein the secure computer infrastructure is secured using encryption” is disclosed in ‘364 col. 11, lines 31-38.

As to dependent claim 14, “wherein a status of the contract is indicated as "Submitted" after the contract is generated, wherein the status is indicated as "New" after approval by the originating contract partner, wherein the status is indicated as "Ready to Sign" after approval by the receiving contract partner, wherein the status is indicated as "Signed" after execution by the receiving contract partner, wherein the status is indicated as "Countersigned" after execution by the originating contract partner, and wherein the

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status is indicated as "Complete" after the final image is generated" is disclosed in '364 col. 11, lines 3-30 .

As to dependent claim 15, "further comprising receiving an issue list from the receiving contract partner if approval of the contract by the receiving contract partner is not obtained" is taught in '364 col. 11, lines 31-53 .

As to dependent claim 16, "further comprising blocking out comments input by the receiving contract partner is approval of the contract by the receiving contract partner is obtained" is shown in '364 col. 7, line 59 through col. 8, line 8.

As to independent claim 17, this claim is directed to a system for executing the method of claim 1; therefore it is rejected along similar rationale.

As to dependent claims 20-25, these claims contain substantially similar subject matter as claims 2-11, and 14-16; therefore they are rejected along similar rationale.

As to independent claim 26, this claim is directed to a program product for causing a computer to execute the method of claim 1; therefore it is rejected along similar rationale.

As to dependent claims 29-34, these claims contain substantially similar subject matter as claims 2-11, and 14-16; therefore they are rejected along similar rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 12, 13, 18, 19, 27, and 28,** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tackman et al. U.S. Patent No. 7,051,364 (hereinafter '364) in view of Cornelius et al. U.S. Patent No. 7,069,234 (hereinafter '234).

As to dependent claim 12, the following is not explicitly taught in '364: **“further comprising registering the receiving contract partner prior to the obtaining step, wherein the registering step comprises: obtaining profile information for the receiving contract partner; communicating a URL corresponding to the secure infrastructure to the receiving contract partner; and providing login information to the receiving contract partner upon selection of the URL”** however '234 teaches that transactions are monitored for security that user are accurate based on user names passwords and IP address in col. 24, lines 19-33.

It would have been obvious to one of ordinary skill in the art at the time of the invention a system and method for preparing secure electronic documents taught in '364 to include to utilize the features available in the Internet environment. One of ordinary skill in the art would have been motivated to perform such a modification to utilize a network to provide negotiate the terms of a trade see '234 (col. 3, lines 17-48) “A bank incurs roughly the same expenses in connection with an L/C, independent of the value of the goods to which the L/C pertains. The bank's fee is sometimes expressed as a percentage of the amount of the L/C, such as 1%. Assuming, for example, that the bank's expenses are \$10,000, it will be appreciated that the bank

is reluctant to open an L/C for transactions involving less than \$1,000,000 of goods, as this business is not profitable for the bank. Thus, it is difficult for parties wishing to participate in international trade to use the L/C mechanism when the value of the goods involved in a transaction is small enough that the expense of an L/C becomes significant. The present disclosure provides for initiation of an agreement utilizing a network”.

As to dependent claim 13, “wherein the registering step further comprises checking a credit of the receiving contract partner” however ‘234 teaches in col. 10, lines 45-50, VTrade will access the credit worthiness.

As to dependent claims 18, 19, 27, and 28, these claims contain substantially similar subject matter as claims 12 and 13; therefore they are rejected along similar rationale.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (571) 272-3842. The examiner can normally be reached from 6:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Ellen Tran", followed by three slanted parallel lines (///) indicating the end of the signature.

Ellen Tran
Patent Examiner
Technology Center 2134
23 June 2007